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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANDERS R. WALLGREN,  
PRAVIN S. KOTHARI,  
ELIZABETH A. CLEARY,  
PHILIP C. NELSON, and  
BRETT E. BATTLES

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Appeal 2008-5868  
Application 09/328,983  
Technology Center 3600

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Decided:<sup>1</sup> March 24, 2009

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*Before* HUBERT C. LORIN, DAVID B. WALKER, and  
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

Anders R. Wallgren, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 23-38. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.<sup>2</sup>

## THE INVENTION

“The present invention relates to electronic commerce applications and, in particular, such applications as may be used for computer-based contracting among customers and vendors.” Specification 2:5-7.

Claim 23, reproduced below, is illustrative of the subject matter on appeal.

23. A computer-based contracting method comprising:

receiving a user-supplied set of constraints regarding a print job project;

storing the set of constraints in a database as an object;

creating a plurality of instances of the object, each instance uniquely associated with a corresponding vendor;

communicating each instance of the object to its corresponding associated vendor;

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<sup>2</sup> Our decision will make reference to the Appellants’ Appeal Brief (“Br.,” filed Sep. 5, 2007) and the Examiner’s Answer (“Answer,” mailed Oct. 2, 2007).

receiving communications from the user and the vendors to iteratively modify the instances of the object, the modifications further constraining the print job project;

selectively displaying to the user the modified instances of the object individually or collectively; and

receiving a selection from the user of one of the vendors to complete the print job project.

### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Huberman	US 5,826,244	Oct. 20, 1998
Hill	US 5,970,471	Oct. 19, 1999
Thackston	US 6,295,513 B1	Sep. 25, 2001

The following rejection is before us for review:

1. Claims 23-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thackston, Hill, and Huberman.

### ISSUE

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 23-38 under 35 U.S.C. § 103(a) as being unpatentable over Thackston, Hill, and Huberman. The issue turns on

whether Thackston discloses the claim step “creating a plurality of instances of the object, each instance uniquely associated with a corresponding vendor” (claim 23).

## PRINCIPLES OF LAW

### *Obviousness*

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

## ANALYSIS

The Examiner argues that

Thackston teaches using web browser templates to submit RFQ form and the RFQ form includes constraints, such as quantity requirements, schedule requirements, delivery requirements, date

and time of bidding enabling vendors to bid and negotiate the terms and conditions to and fro (see at least col. 50, line 31-col. 51, line 48, col. 13, lines 1-25 and col. 25, lines 25-58).

Answer 6-7. According to the Examiner, “Thackston discloses that such RFQ forms/templates are stored as objects in an object-oriented database see at least col. 6, lines 50-53 and col. 43, lines 33-38.” Answer 7. As for the claim limitation of “*creating a plurality of instances of the object, each instance uniquely associated with a corresponding vendor*” (claim 23 (emphasis added)), the Examiner takes the position that

[i]n response to receiving the user’s RFQ with a set of constraints[,] *vendors responses[,] and iterative responses* during negotiations to arrive at an agreed data relating to specifications, schedules, delivery requirements, bids, etc. *correspond to creating a plurality of instances wherein each instance is uniquely associated with a corresponding vendor.*

Answer 7 (emphasis added).

The Appellants disagree, arguing that if the Examiner is of the opinion that “the RFQ form constitutes the claimed user-supplied set of constraints regarding a print job project” (Br. 8) as the Examiner suggests, then to meet the claimed subject matter, “Thackston should disclose storing the RFQ in a database as an object, and creating a plurality of instances of the RFQ, each instance uniquely associated with a corresponding vendor.” Br. 8. According to the Appellants, “Thackston does not, however, describe or suggest anything of the sort, and the Examiner has failed to identify any such description or suggestion.” Br. 8.

Thackston discloses a computer-based system for “undertaking an engineering design and development effort in a virtual collaborative environment” (col. 1, ll. 20-22). To that end, Thackston describes a “network-based interactive system that supports several phases of an engineering effort: the development and evaluation of an engineering design, the identification of potentially qualified fabricators, and the bidding and negotiation process to create an agreement for a qualified fabricator to manufacture a design in quantity.” (Col. 4, ll. 45-50). There are three aspects to the Thackston system. First, there is a server to undertake the design development effort and which interfaces with user systems via a graphical user interface, such as a browser (col. 5, l. 4). Second, there is a database of fabricators, called a “Global Manufacturer’s Registry” (GMR) (col. 5, l. 31). And, third, there is

an electronic bidding system . . . provided by an Electronic Trading Community (ETC) to allow virtual discussions and negotiations to take place over the networked system once a pool of qualified fabricators is identified. A request for quote (RFQ) or request for proposal (RFP) with design data is submitted to the system so that fabricators can submit proposals.

Col. 5, ll. 55-61. An understanding of this third aspect of Thackston’s system is central to resolving whether Thackston discloses the claim step of “creating a plurality of instances of the object, each instance uniquely associated with a corresponding vendor” (claim 23).

The Examiner appears to be accurate in arguing that “Thackston teaches using web browser templates to submit RFQ form and the RFQ form

includes constraints, such as quantity requirements, schedule requirements, delivery requirements ....” Answer 6-7. The passage at col. 50, ll. 43-65 supports the Examiner:

Continuing with the ETC aspect of the invention, the RFQ may be submitted or "posted" to GMR graphics server 2710 via browser templates completed by GMR user 2600. The RFQ may include such information as a project identifier, narrative description, quantity requirements, schedule requirements, delivery requirements, and the like. The RFQ may include information pertaining to how many "rounds" of bids will be considered, or as to whether a given round is a so-called "best and final" offer round. The RFQ may include information identifying the bidding pool. When the second (GMR) and third (ETC) aspects of the invention are integrated, the RFQ form may include a listing of the qualified fabricators identified by a search. Prime contractor GMR user 2600 may then select from the list so that the RFQ is directed to the selected fabricators. The RFQ may include information identifying the date and time for the bidding round(s), such as indicating the bidding window begins at 8:00 a.m. on November 7 and ending at 4:30 p.m. on November 14. The RFQ may also include information identifying that period when the part design model (and associated) data will be available and/or when GMR user 2600 will be available for conducting multimedia communications sessions to discuss issues.

The Examiner however is not accurate in arguing that “Thackston discloses that such RFQ forms/templates are stored as objects in an object-oriented database see at least col. 6, lines 50-53 and col. 43, lines 33-38.”



Answer 7. (See also Answer 11-12 for a similar position.) While Thackston discloses that the RFQ form “may be submitted or ‘posted’ to GMR graphics server 2710” (col. 50, l. 44; referring to Fig. 26) and which server could be represented by the GMR server system 1000 (col. 49, ll. 48-49 see Fig. 20), there is no express disclosure of storing the form in a database, let alone an object-oriented database. The passages at col. 6, ll. 50-53 and col. 43, ll. 33-38 to which the Examiner refers are not clearly supportive of the Examiner’s statement. The former disclosure provides a general description of the third aspect of Thackston’s system with no mention of an RFQ “form,” a server, or database. The latter disclosure describes the possibility of using “object-oriented” databases as means for storing and providing data for the GMR database of *fabricators*. See Fig. 22, element 1100. There is no discussion of using the “object-oriented” databases to store any information related to the bidding process. The latter disclosure refers to the second aspect of Thackston’s system, not to the electronic bidding third aspect of Thackston’s system.

Arguably, given Thackston’s desire to bring together all three aspects of the system to create an integrative design and development system, one of ordinary skill in the art reading Thackston as a whole might be led to consider storing the RFQ form in the GMR database and thereby integrate the RFQ form with other design information as part an overall engineering, design, and bidding system. However, the issue is not simply whether Thackston would have rendered storing constraints in an object-oriented database obvious to one of ordinary skill in the art, but whether Thackston would have led one of ordinary skill in the art to further “creat[e] a plurality

of instances of the object, each instance uniquely associated with a corresponding vendor” (claim 23).

Even if we assumed *arguendo* that Thackston would lead one to store the RFQ form in an object-oriented database, to render the claimed subject matter obvious, Thackston would have to further lead one of ordinary skill in the art to create a plurality of instances of the RFQ form, as an object, and each instance being uniquely associated with a corresponding vendor. The Examiner takes the position that “[i]n response to receiving the user’s RFQ with a set of constraints[,] vendors responses[,] and iterative responses during negotiations to arrive at an agreed data relating to specifications, schedules, delivery requirements, bids, etc. correspond to creating a plurality of instances wherein each instance is uniquely associated with a corresponding vendor.” Answer 7. The difficulty with this position is that Thackston does not disclose vendor responses during the bidding process as instances of the RFQ form as an object. While Thackston describes the bidding process as one involving the bidder viewing the RFQ (col. 50, l. 67-col. 51, l. 8) and submitting a bid (col. 51, ll. 9-25), there is no disclosure to suggest that the bids or information relevant to the bidding process are instances of the RFQ form as an object. While Thackston discloses a bidding process that would produce bids and supplemental information uniquely associated with a corresponding vendor, Thackston discloses no connection between the bid/supplemental information and the RFQ form. While Thackston discloses the display of the RFQ form, the relationship between the bidding information and the form is not explained. Accordingly, in contradistinction to the Examiner’s position, Thackston does not disclose “vendors responses and iterative responses during negotiations

to arrive at an agreed data relating to specifications, schedules, delivery requirements, bids, etc.” (Answer 7) as instances of the form as an object as required by claim 23.

Because Thackston does not support the Examiner’s position, a prima facie case of obviousness has not been established for the subject matter of method claim 23 or claims 24-30 that depend therefrom.

As to the apparatus claims 31-38, they require a database comprising objects uniquely associated with corresponding vendors and a web server adapted to selectively display modified instances of the objects. The Examiner relies on the position taken with respect to the method claims. Answer 8. In that regard, while Thackston arguably discloses object-oriented databases and vendor responses, Thackston does not disclose the responses as objects in a database such that the responses would be objects uniquely associated with corresponding vendors. Accordingly, there would be no reason for one of ordinary skill in the art to provide a system comprising a web server adapted to selectively display modified instances of the objects. Accordingly, a prima facie case of obviousness has not been established for the subject matter of apparatus claims 31-38.

### CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 23-38 under 35 U.S.C. § 103(a) as being unpatentable over Thackston, Hill, and Huberman.

DECISION

The decision of the Examiner to reject claims 23-38 is reversed.

REVERSED

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